

Appl. No. : 10/810,789  
Filed : March 26, 2004

REMARKS

The Examiner's Action dated April 28, 2006 has been received and an attempt has been made to carefully consider its contents. In this response the Applicant respectfully requests that the Examiner reconsider his position and withdraw the restriction requirement in view of the following comments. In the alternative, the Applicant elects Claim Group II, namely Claims 24-29, and Claims 30-36 with traverse set forth below. The Applicant has added new claims 30-36 and submit that based on the prior restriction requirement these claims should not be subject to restriction requirement. New Claims 30-36 include the limitation that the top surface of the test die, i.e. non-functional die, have conductive electrical path thereon. Since this limitation being in one claim and not the other was cited as the basis for the Examiner's restriction, Applicant submits that Claims 24 and 30 should not be restricted.

In particular, the has Applicant's attorney is unable to understand the basis for the Examiner alleging that Claim Group I, Claims 11-18 are classified in Class 257 while Claim Group I, Claims 11-18 are classified in Class 267. Class 267 is directed to Spring Devices, which is in no way related to the present subject matter. Applicant request clarification.

In addition, Applicant submits that the Examiner is improperly interpreting and applying the rules regarding restrictions. The Examiner's interpretation for a restriction would require that any claim which has slightly different wording would qualify for a restriction. Based on the Applicant's interpretation of the Examiner's statements during the telephone conference of July 26, 2006, the Examiner stated that a different limitation within a claim will necessitate a restriction. This is wrong. A restriction requirement should not be issued when claims simply contain different limitations. If all claims contained the exact same limitations there would only be a need for one independent claim. Section 800 of the MPEP which sets forth that restrictions are proper when claims are both Independent and Distinct.

A claim is Independent when there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation and effect. MPEP 802.01 For the Examiner to allege that Claim 11 and Claim 24 are unconnected in design, operation and effect is simply ridiculous. Applicant requests that the Examiner provide an explanation of why

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there is no relationship between Claim 11 and Claim 24 and why these two claims are unconnected in design.

Claim 11 and 24 are set forth below with common sections highlighted, underlines and bolded. Given the similarity between these claims, it is difficult to appreciate the burden (MPEP § 803) that would be placed on the Examiner by searching for prior art for both claims.

Claim 11	Claim 24
(Withdrawn) A package test device comprising:	30. (New) A package test device comprising, in combination:
<u>a test die comprising a non-functional die having a <i>top layer</i> configured for package testing and having two or more pads;</u>	<u>at least one non-functional die resembling a functional die, the at least one non-functional die having at a first pad and a second pad and <i>at least one electrical path between a first pad and a second pad</i>; (see Claim 13)</u>
<u>a package enclosing the non-functional die;</u>  <u>two or more contacts external to the package, the two or more contacts configured to provide electrical access to the non-functional die; and</u>	<u>a package substantially surrounding and protecting the at least one non-functional die, wherein the package further comprises <i>at least two external connection points which provide electrical access to the at least one non-functional die</i> from an outer portion of the package to test the ability of the package to protect and contain the at least one non-functional die.</u>
<u>two or more conductors extending between the two or more contacts and the two or more pads.</u>	<u>at least one conductor having first end <i>coupled to the first pad and a second end in electrical contact with at least one of the at least two external connection points</i>; and</u>  <u>at least one conductor having first end <i>coupled to the second pad and a second end in electrical contact with at least one of the at least two external connection points</i>.</u>
Claim 13 - The device of Claim 11, wherein the <i>top layer</i> further comprises <i>one or more conductive traces extending over the top surface</i> .	

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As is shown in this table, the claims are almost identical. Contrary to what the Examiner asserts, the fact that these claims are not identical is not reason for a restriction requirement. Applicant acknowledges the Examiner's statement during the conference call that 30 different claims directed to different subject matter would prevent an accurate search and should be restricted. That is however, not the case here as there are only two independent claims which are almost identical. Applicant has invested substantial time in this case and the assignee of record has invested substantial money in this case and paid substantial fees to the Patent Office and simply requests that which it is entitled, namely a fair examination on the merits.

#### SUMMARY

Applicant has elected Claims 24-29 and added new Claims 30-36. If any matters remain outstanding, the Examiner is invited to contact the undersigned by telephone. Please deduct any fees incurred by this Response, beyond those provided herewith by check, for the requested 2 month extension of time from our Deposit Account No. 502200.

Dated: 7/28/06

Respectfully submitted,

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